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09/973,458	04/03/2001	Venkata Katikaneni	F-113	8314

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/973,458	KATIKANENI ET AL.	
Examiner	Art Unit	
Edward R. Cosimano	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a): In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-37 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.
3. The proposed drawings filed 20 September 2004 are acceptable.
4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
5. Claims 13-37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - 5.1 In regard to claims 13-37, although on of ordinary skill at the time of the invention would known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:
    - A) in regard to claims 13 & 21 and how a "printer" which is located in proximity to the path of travel can print a "postage indicia" and an "ad slogan" at a location on an envelope indicated by the operator, since the invention as recited in these claims clearly fails to:

(1) indicate whether the printer actually is placed so that an envelope that is being transported along the travel path will pass the print head of the printer in the recited "print position" so that the print head may operatively print a "postage indicia" and/or an "ad slogan" at the location on an envelope that was indicated by the operator;

(2) detect when the envelope that is being transported along the travel path is properly positioned in the print position so that the print head of the printer may operatively print a "postage indicia" and/or an "ad slogan" at the location on an envelope that was indicated by the operator; and

(3) indicate how the printer would know when to start and/or stop printing a "postage indicia" and/or an "ad slogan" so that they would appear at the location on an envelope that was indicated by the operator.

B) in regard to claims 13 & 25 and how the "control system" can obtain an "indication from an operator of a selected print location for the ad slogan", since the invention as recited in these claims clearly fails to recite an input device that is connected to the control system for use by the operator when indicating the position of the ad-slogan.

C) in regard to claims 13, 14, 25 & 26 and how the "control system" can determine "if the postal indicia and the ad slogan can be printed in a single pass" or would require multiple passes, since the invention as recited in these claims clearly fails to recite any information concerning either:

(1) the dimensions of the ad slogan; and/or

(2) the postage indicia;

relative to the either:

(1) the relative position of the "ad slogan" with respect to the "postage indicia"; and/or

(2) the size of the envelope; and/or

(3) size of print head;

Art Unit: 3629

that would permit a determination of whether or not a single pass or multiple passes of the print head are required to print the postage indicia and ad slogan at the indicated location on the envelope.

D) in regard to claims 14, 21, 26 & 34 and how the second pass through the postage printing system is accomplished, since the invention as recited in this claim clearly fails to recite any structure or function of the system that would permit either:

(1) a determination of whether a pass is the “first pass” or the “second pass” through the postage printing system; and/or

(2) a “second pass” through the postage printing system.

E) in regard to claims 15, 21, 27 & 34 and how the “control system” can indicate to the operator the “anticipated orientation of the envelope”, since the invention as recited in these claims does not have a means connected to the “control means” that could perform this function.

F) in regard to claims 16-20, 22-24, 28-33 & 35-37 and how the “control system” may use the “distinguishing characteristic of the envelope” to either:

(1) determine if the detected feature is the “postage indicia:

(2) determine the orientation of the envelope being fed;

(3) bypass printing of the ad slogan if the detected orientation does not match the anticipated orientation; and

(4) determine if the indicia is printed at the top of the envelope;

since the invention as recited in these claims the control system:

(1) is not connected to the “scanner”;

(2) does not know what pass is occurring;

(3) does not know if the indicia has or has not been printed; and

(4) top of the envelope has not been determined.

G) in regard to claims 18, 24, 30, 33 & 37 and whether the “ad slogan” should be printed upside down, since the invention as recited in these claims does not require the control system to use the determination of the anticipated/actual feed orientation of the envelope when making this decision.

Art Unit: 3629

5.2 Claims 13-17, 19, 20, 25-29, 31 & 32 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claims 13-17, 19, 20 recite a postage printing system, however these claims fail to actually print a postage indicia, since:

(1) claim 13 recites a wall, transport device, a printer and a control system, where the printer is capable of printing an indicia but as recited in the claim does not print a postage indicia and the control system merely determines whether one or two print passes are required;

(2) claim 14 merely recites how the printer is controlled;

(3) claim 15 merely recites providing information to the user about the orientation of the envelope;

(4) claims 16, 17, 19 & 20 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

B) in regard to claims 25-29, 31 & 32 recite a postage printing system, however these claims fail to actually print a postage indicia, since:

(1) claim 25 recites a transport device, defining possible print positions, obtaining a indication of the location of message/slogan/ad; and determining whether one or two print passes are required;

(2) claim 26 merely recites how the printer is controlled;

(3) claim 27 merely recites providing information to the user about the orientation of the envelope;

(4) claims 28, 29, 31 & 32 merely recite detecting the orientation of the envelope and controlling how the data is to be printed

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

Art Unit: 3629

5.3 For the above reasons, applicant has failed to particularly point out what is regarded as the invention.

6. Claims 13-37 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 6,356,883 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

6.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) a transport path for transporting envelopes during multiple passes through a postage printing system

B) a printer for printing postage indicia and messages/slogans/ads on the envelope in the indicated positions;

C) a control system for obtaining an indication of the location that the message/slogan/ad is to be printed and determining if the both the indicia and the message/slogan/ad can be printed in one or two passes of the envelope through the postage printing system and the corresponding orientation of the ad slogan during printing.

6.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3629

6.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7.1 Claims 13-37 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 The instant claims recite a system, (claims 13-24), and a method comprising a series of steps to be performed on a computer, (claims 25-37), which have a disclosed practical application in the technological or useful arts. Further, the instant claims do not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon.

7.1.2 In regard to claims 13-37, the invention as set forth in these claims merely describes:

A) in regard to claims 13-20 & 25-33 a system and method of determining the orientation of an envelope and the number of printing passes required to print the postage indicia and an ad slogan on an envelope as the envelope is being transported through a postage printing system, with out using the results of the determination to control the operation of the postage printing system.

B) in regard to claims 21-24 & 34-37 a system and method of indicating the orientation of an envelope during a number of printing passes that are required to print the postage indicia and an ad slogan on an envelope as the envelope is being transported through a postage printing system, with out using the requirement that the determined orientation be used during the operation of the postage printing system.

However, the process/system as recited in these claims does not apply the result of either the claim as a whole or the manipulations of data as recited in these claims in such a manner so as to be tangibly used in a concrete manner and hence to produce a useful concrete and tangible result, that is a concrete and tangible application with in the technological or useful arts.



Art Unit: 3629

7.1.3 It is further noted that applicant has not recited in these claims a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either:

- A) altered or changed or modified by the invention recited in claims; or
- B) utilizes the result of the invention recited in these claims; or
- C) is operated or controlled by the result of the invention recited in these claims.

7.1.4 It is further noted in regard to claims 13-37, that as claimed applicant has not claimed:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or transformed/changed before it is processed; or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation, is neither manipulated nor used nor changed by any device after it has been processed; or

C) a practical use of the claimed invention by any physical system or device or method outside of a statement of the intended use of the claimed invention; or

D) process steps or physical acts/operations that would affect the internal operation of a computer/machine as were found to be statutory in either In re McIlroy 170 USPQ 31 (CCPA, 1971) or In re Waldbaum 173 USPQ 430 (CCPA, 1972); or

E) process steps or physical acts/operations that would be considered as going beyond the manipulation of “abstract ideas” as were found to be non-statutory in In re Warmerdam 31 USPQ2d 1754 (CAFC, 1994); or

F) a concrete and tangible practical application of either:

- (1) the invention as a whole; or
- (2) the final results of the manipulations/actions with in the technological or useful arts;

note In re Sarkar 200 USPQ 132 (CCPA, 1978) where the process step of “constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model” was held to be so tenuous connected to the remaining process steps as to not be a process with in the scope of 35 U.S.C. § 101.

Art Unit: 3629

Hence, the invention of claims 13-37 is merely directed to an hypothetical mental exercise that manipulates an abstract idea of determining the number of passes (claims 13-20 & 25-33) and the orientation of an envelope (claims 21-24 & 34-37) with out a claimed concrete and tangible practical application of the abstract idea, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

7.1.5 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

7.1.6 In practical terms, claims define nonstatutory processes if they:

A) consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or

B) simply manipulate abstract ideas, e.g., a bid (Schrader, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759),

without some claimed practical application of the mathematics or abstract idea.

7.1.7 In view of the above analysis claims 13-37, as a whole, are directed to an hypothetical mental exercise that merely manipulates mathematics or an abstract idea without a claimed concrete and tangible practical application of the mathematics or abstract idea, and hence are directed to non-statutory subject matter.

7.2 Claims 13-37 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.2.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing

the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.";

and "Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.", {emphasis added}.

7.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are

required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

7.2.3 As can be seen from claims 13-37, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 13-37 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

7.3 Claims 13-17, 19, 20, 25-29, 31 & 32 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that claims 13-17, 19, 20, 25-29, 31 & 32 lack utility since these claims do not require the printing of postage.

In view of the above, it is considered that the invention of claims 13-17, 19, 20, 25-29, 31 & 32 lack substantial and practical utility.

7.4 Claims 13-37 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 13-37, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.

B) in regard to claims 13, 14, 25 & 26, these claims fail to comply with the “requirements this title, namely 35 U.S.C. § 103 as set forth below.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 13, 14, 25, 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee et al (5,168,804) in view of either Hunter (5,493,106) or Kara (5,717,597) as suggested by Storace et al (5,831,554) and further in view of Cannon et al (5,748,484).

8.1.1 In regard to claims 13 & 25, Lee et al ('804) discloses a postage metering system in which a transportation system moves an item of mail by a postage printer. Where the postage printer will print a postage indicia and may print a personalized message or advertisement. Although the postage printing system of Lee et al ('804) teaches that the user selects a personalized message or advertisement that is automatically positioned, the system of Lee et al ('804) uses print dies that do not easily allow for the user to select variable message or advertisement to be printed with the postage indicia.

8.1.2 In the environment of postage metering systems, either Hunter ('106) or Kara ('597) disclose a postage metering system. In the postage metering systems of either Hunter ('106) or Kara ('597) it is desirable to allow the user to personalizing the item of mail, for example a card, by selecting the message or advertisement. The selected message or advertisement is then printed with the postage indicia by the postage printers of either Hunter ('106) or Kara ('597).

Art Unit: 3629

8.1.3 It is noted that the printing system of Lee et al ('804) will not support the wide selection of personalized messages or advertisements suggested by the systems of either Hunter ('106) or Kara ('597). However in the environment of postage metering systems, Storace et al ('554) discloses that it is desirable to modify the postage printer in the postage metering system of Lee et al ('804) to include a digital printer such as a ink jet printer or thermal printer. Such a modification permits the user to select the personalized message or advertisement that is to be printed with the postage indicia as taught by either Hunter ('106) or Kara ('597).

8.1.4 Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the postage printer of Lee et al ('804) could be replaced by a digital printer as taught by Storace et al ('554) so that the user may easily select the personalized message or advertisement that is automatically positioned so as to be printed with the postage indicia as taught by either Hunter ('106) or Kara ('597).

8.1.5 However, Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) does not disclose a control system that:

A) receives an indication from the user of the placement of the message/advertisement; and

B) determines if one or two printing passes are required to print the combination of a postage indicia and message/advertisement at the desired location.

8.1.6 In the environment of personalizing items of mail, Cannon et al ('484) discloses a system in which the user is permitted to select the location on an item at which personalized text is to be placed. In the system of Cannon et al ('484) as disclosed at column 11, line 46, to column 12, line 31, the user selects the location of images and/or text that is to appear on the item of mail. Based on the user's selections, the item of mail is printed. Such a system permits the user more control over the appearance of the item of mail.

10.1.7 Since the function of either Hunter ('106) or Kara ('597) or Cannon et al ('484) is to personalize item of mail, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) could be further

Art Unit: 3629

modified to permit the user to select the location on the item of mail at which the message or advertisement is to be printed as taught by Cannon et al ('484).

8.1.8 In regard to the need to use one or two printing passes, it is noted that the physical components of the postage metering and printing system as well as the size of the message or advertisement to be printed govern how many printing passes are required to print the postage indicia and personalized message or advertisement. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) could be further modified to indicate to the user that one or more printing passes are required in order to print the postage indicia and personalized message or advertisement.

8.1.9 In regard to the order in which the postage indicia and personalized message or advertisement are printed as recited in claims 14 & 26, since the result of the postage metering systems of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) is to produce an item of mail with a postage indicia and a personalized message or advertisement, it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Lee et al ('804) as modified by the teaching of Hunter ('106) or Kara ('597) in view of Storace et al ('554) and as modified by Cannon et al ('484) could print the indicia or message in any sequence so long as both the indicia and message are placed in the item of mail.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) Lee et al (5,168,804) discloses a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail, where the prior art required the user to manually position the personalized message or advertisement, the current system would automatically position the personalized message or advertisement.

(2) either Hunter (5,493,106) or Kara (5,717,597) or Storace et al (5,831,554) or Cannon et al (5,748,484) disclose a postage metering system in which an user selects a personalized message or advertisement and the location that the message or advertisement is to be placed on an item of mail.

B) however, in regard to claims 15, 21, 27 & 34, the prior art does not teach or suggest indicating to the user the anticipated orientation of the item of mail during the subsequent printing passes. Claims 16-18, 22-24, 28-30 & 35-37 are allowable for the same reason.

C) however, in regard to claims 16, 19, 22, 28, 31 & 35 the prior art does not teach or suggest using a scanner to detect distinguishing characteristics of the item of mail. Claims 17, 18, 20, 23, 24, 29, 30, 32, 33, 36 & 37 are allowable for the same reason.

D) however, in regard to claims 18, 24, 29, 33 & 37, the prior art does not teach or suggest printing the message or advertisement in a particular orientation based on the selected location to print the message or advertisement.

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the 35 U.S.C. § 103 and double patenting rejections, since applicant has made vague generalized assertions that these rejection are improper with out supporting evidence or arguments, applicant's arguments are non persuasive.

11. Claims 15-20 & 27-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If



Art Unit: 3629

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

15.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

15.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

15.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

01/27/05

A handwritten signature in cursive script, reading "Edward R. Cosimano".

Edward R. Cosimano

Primary Examiner A.U. 3629